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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/650,410

08/28/2003

Klausjoerg Klein

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12/11/2006

E I DU PONT DE NEMOURS AND COMPANY
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4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER

MAYEKAR, KISHOR

ART UNIT

PAPER NUMBER

1753

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/650,410		KLEIN ET AL.	
	Examiner		Art Unit	
	Kishor Mayekar		1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/03 & 2/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to a process for producing a CED coating, classified in class 204, subclass 471+.
 - II. Claim 12, drawn to a coated product, classified in class 428, subclass 622+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I and II are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a non-electrocoating process.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Attorney W. Fricke on 4 December 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claim 12 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 1, the recitation "a CED coating" in the preamble is confusing because the term CED is not defined. The recitation "thermally crosslinking the CED coating film" as whether the film here is after step a. or step b. The Markush group is improperly recited because the missing term "and" in the Markush group's format "selected from the group consisting of A, B and C".

In claim 10, the recitation "the substrates" in plural is confusing since claim 1 recites it in singular.

Claim Rejections - 35 USC § 102 and § 103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 1, 2, 4-6, 8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Opitz (US 5,810,987) in light of Eswarakrishnan et al. (US 5,356,529) or Hawkins et al. (US 5,047,128). Opitz's invention is directed to a method for the electrophoretic dip coating of small items. Opitz discloses that the process comprises the steps of cathodically dip coating the items having an electrically conductive surface in a dip bath, removing the coated items from the dip bath, rinsing the coated items with an ultrafiltrate, and baking the rinsed items wherein the items to be coated are placed on a conductive conveyor belt (Fig. 1; col. 7, lines 34-44; paragraph crossing cols. 7 and 8; and col. 8, lines 18-20). The difference between Opitz and the above claims is the detailing that the ultrafiltrate contains a metal compound as claimed. Eswarakrishnan shows in an electrocoating process that organotin catalysts added to an electrodeposition coating composition is often found in the ultrafiltrate (col. 1, lines 26-41). Hawkins explains in an electrocoating process for electrodepositing a film from a paint bath that ultrafiltration process utilizes a semi-permeable membrane to allow small molecules such as water, solubilizer and ionic salts in the paint bath to pass through while retaining the larger paint particles, and the ultrafiltrate (the liquid passing through) can be used to rinse the coated articles and recover dragged-out paint from the film (paragraph crossing cols. 1 and 2). As such Opitz's ultrafiltrate contains the recited metal compounds.

11. Claims 3, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

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Opitz '987 in light of Eswarakrishnan '529 or Hawkins '128 and in view of Tomizaki et al. (US 6,375,820 B1). The differences between Opitz '987 in light of Eswarakrishnan '529 or Hawkins '128 as applied above and the instant claim are the recited subject matters in each of the instant claims. Tomizaki shows an electrodeposition coating composition for cathodic electrodeposition comprising organotin catalyst in an amount of 11-30 wt% and bismuth salts in an amount of 0.1 to 10 wt% based on resin solids content (col. 4, lines 27-39 and paragraph crossing cols. 4 and 5). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Opitz '987 in light of Eswarakrishnan '529 or Hawkins '128 as shown by Tomizaki because the selection of the concentration of the metal compounds would be within the level of ordinary skill in the art and the provision of bismuth salts in the bath would improve the curability and the corrosion resistance of the electrodeposited coating.

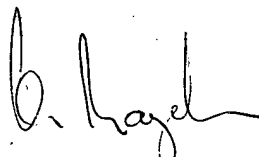
Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'K. Mayekar', is positioned above the printed name.

Kishor Mayekar
Primary Examiner
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